

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andrew Fikes et al. Art Unit : 3622
Serial No. : 10/808,993 Examiner : Namrata Boveja
Filed : March 24, 2004 Conf. No. : 9878
Title : SYSTEM AND METHOD FOR PROVIDING ON-LINE USER-ASSISTED
WEB-BASED ADVERTISING

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Please consider the references listed on the enclosed PTO-1449 form. Foreign patent documents and non-patent literature are enclosed; cited U.S. patents and patent application publications will be provided on request.

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STATEMENT REGARDING REFERENCES IN 1449 FORM

The references in the attached 1449 form are submitted for independent consideration by the USPTO in its examination of the subject patent application. In view of the volume of this material, the following is noted regarding some of the larger references:

The Zeff book (reference C11) generally discusses Zeff's understanding of the state of art of online advertising systems in 1999 (there is an earlier, first edition of this book too, printed in 1997, though for purposes of the present application it is believed that the 1999 book is sufficient. Applicants can provide the 1997 edition at the request of the examiner.) The Zeff book identifies several systems and techniques for online advertising, including self-service online systems, graphical user interfaces, targeting options, campaign strategies, and types of parameters that can be specified regarding advertising. There are screen captures of exemplary systems in use at the time throughout the Zeff book.

The AdForce User Guide (reference C1), dated 1998, is another reference that discusses on line advertising. Various graphical user interfaces and targeting options are shown and discussed in the reference, though chapter 6 appears to have the most detail regarding advertisers, agencies, and advertising campaigns; chapter 7 discusses publisher interfaces,

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targeting options, and delivery and placement techniques; and chapter 9 covers various reporting options. Numerous other topics and techniques are covered in this voluminous reference, which counsel understands to have been a working advertising system.

The AdManager Pro Administrator Manual (reference C6), also dated 1998, is, in general scope, similar to the AdForce User Guide, as it discusses another self-service online advertising targeting system, though it explicitly covers some different advertising techniques and features, such as marrying online advertising and other forms of advertising (e.g. print advertising), and indicates that advertising through such a self-service online system could target multiple different media formats, from online to various manners of print formats.

Lastly, there are several references by Dedrick (references A7, C12, C13) that discuss early computer network-based advertising techniques and targeting options.

Furthermore, the subject patent application generally pertains to technology that is either in use, being considered, or includes potential candidate technology for further development. In this regard, several inter partes reexaminations are identified that the assignee of the present application, Google, has filed, which further describe and characterize some of the references above and several others on the 1449 form. These reexaminations relate to a litigation in the matter Function Media LLC v. Google Inc. and Yahoo!, Inc. (E.D. Tex., Case No. 02:07-cv-279) (pleadings may be found on PACER or at <http://dockets.justia.com>), are:

- Control No. 95/001,061 (references C15, A16), concerning U.S. Patent No. 6,446,045. Google has asserted that what is claimed in the '045 patent, or more particularly the breadth in which it has been asserted against Google in the litigation, is not patentable for several reasons, including in view of the references cited in the reexamination. On September 25, 2008, the USPTO granted Google's reexamination request, finding substantial new questions of patentability were raised by the references cited therein and further issued a 190-page rejection of the claims.
- Control No. 95/001,068 (references C17, A18), concerning U.S. Patent No. 6,829,587 (this patent shares a common written description with the '045 patent). Google contends that what is claimed in the '045 patent, or more particularly the breadth in which it has been asserted against Google in the litigation, is not patentable for several reasons, including in view of the references cited in the reexamination. On October 9, 2008, the USPTO granted Google's reexamination request, finding substantial new questions of patentability were raised by the references cited therein.
- Control No. 95/001,073 (references C14, A15), concerning U.S. Patent No. 7,240,025 (this patent shares a common written description with the '045 patent). Google contends that what is claimed in the '045 patent, or more particularly the breadth in which it has been asserted against Google in the litigation, is not patentable for several reasons, including in view of the references cited in the reexamination. On October 24, 2008, the USPTO granted Google's reexamination request, finding substantial new questions of patentability were raised by the

references cited therein. And, on November 21, 2008, the USPTO further issued a 504-page rejection of the claims asserted against Google in the above-referenced litigation.

- Control No. 95/001,069 (references C16, A17), concerning U.S. Patent No. 7,249,059 (while this patent shares a common written description with the '045 patent, it also adds a substantial amount of new matter concerning so-called "third party professionals"). Google contends that what is claimed in the '045 patent, or more particularly the breadth in which it has been asserted against Google in the litigation, is not patentable for several reasons, including in view of the references cited in the reexamination. On October 17, 2008, the USPTO granted Google's reexamination request, finding substantial new questions of patentability were raised by the references cited therein and further issued 262-page rejection of the claims.

If the examiner believes that additional information on any of these topics would be helpful, an interview can readily be arranged or the examiner is invited to request such additional information in any manner that is convenient.

Date: _____

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Respectfully submitted,

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